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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,386	01/11/2002	Kazuo Fujiura	P 284993 T4KM-01S1334-1	5480
909	7590	01/27/2005	EXAMINER AGUSTIN, PETER VINCENT	
PILLSBURY WINTHROP, LLP P.O. BOX 10500 MCLEAN, VA 22102			ART UNIT 2652	PAPER NUMBER

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/042,386

Applicant(s)

FUJIURA, KAZUO

Examiner

Peter Vincent Agustin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2004.
- 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 10-12, 14 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 10-12, 14 and 21-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3, 4, 10, 12 & 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Mogi et al. (JP 08-249802; see English translation).

In regard to claim 1, Mogi et al. disclose an information storage medium (Drawing 1) comprising a disc-like shape substrate having a center hole and a peripheral side (107), said medium comprising: a data area formed on the substrate and configured to store or record information; a clamp area located outside the center hole and inside the data area; and at least one notch or groove provided on at least one portion of the peripheral side (see Drawing 1(b)).

In regard to claim 3, Mogi et al. disclose that said medium is an optical disc formed of double disc substrates being adhered together with a given adhesive (see Drawings 1 & 2 and paragraph 14, line 2).

In regard to claim 4, Mogi et al. disclose that said at least one notch or groove is formed at an edge of the peripheral side (see Drawing 1(b)) to enable tactual recognition (paragraph 14, line 4: “finger”) of the notch or groove.

In regard to claim 10, Mogi et al. disclose that said medium comprises a front surface and a rear surface (paragraph 14, line 2: “double-sided”), and wherein said data area is provided on the front surface (interpreted as the surface where data is recorded).

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In regard to claim 12, Mogi et al. disclose that a label area is provided on the rear surface (suggested by paragraph 4).

In regard to claims 14 & 21, Mogi et al. disclose that said at least one notch or groove is configured to indicate a type, or a kind, or a medium side, or contents of the medium (paragraph 12, line 5: "perform distinction").

In regard to claims 22 & 23, Mogi et al. disclose that said peripheral side is provided with a plurality of portions each having said at least one notch or groove (see Drawings 1, 2 & 7; and applicant's admission on page 6, last paragraph of the amendment dated November 16, 2004: "along the entire peripheral edge of the disk").

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mogi et al.

For a description of Mogi et al., see the rejection above. However, in regard to claim 2, Mogi et al. do not disclose that said medium is an optical disc formed of a single disc substrate.

It would have been obvious, however, to one of ordinary skill in the art at the time of invention by the applicant to have used a single-substrate optical disc in lieu of the double-substrate disc of Mogi et al. (see paragraph 14, line 2) because the applicant has not disclosed that using a single-substrate disc provides an advantage, is used for a particular purpose, or solves a stated problem, and one of ordinary skill in the art would have expected the applicant's

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invention to perform equally well with either the double-substrate disc taught by Mogi et al. or the claimed single-substrate disc because both single and double-substrate discs comprise a clamp area and an outer peripheral area where the claimed “notches” or “grooves” might be place. Furthermore, Mogi et al. recited the use of a double-substrate disc as an “example” (paragraph 14, line 2), but the teachings of Mogi et al. are obviously applicable to single-substrate discs as well.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mogi et al. in view of Hida (JP 2000-149403).

For a description of Mogi et al., see the rejection above. However, in regard to claim 11, Mogi et al. do not explicitly disclose that said data area is also provided on the rear surface.

Hida discloses an optical storage device having a data area provided on the rear surface (see basic-abstract, novelty). It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have provided the data area of Mogi et al. on the rear surface as suggested by Hida, the motivation being to increase the access of duration, thereby raising access (reproduction) capability (see advantage).

### ***Response to Arguments***

6. Applicant's arguments filed November 16, 2004 have been fully considered but they are not persuasive.

In regard to independent claim 1, the applicant argues on page 6, last paragraph that Mogi et al. teaches away from having at least one notch or groove provided on a portion of the peripheral side of the disk. The examiner disagrees. As shown on at least Drawing 1, Mogi et al. discloses at least one notch or groove provided on a portion of the peripheral side of the disk.

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In regard to claims 2-4, 10-12, 14 and 21-23, the applicant argues on page 7, paragraph 2 that these claims are patentable for at least the reasons presented with respect to claim 1, as well as for their additional limitations. The examiner disagrees for the reasons regarding claim 1, and the art rejections noted above.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

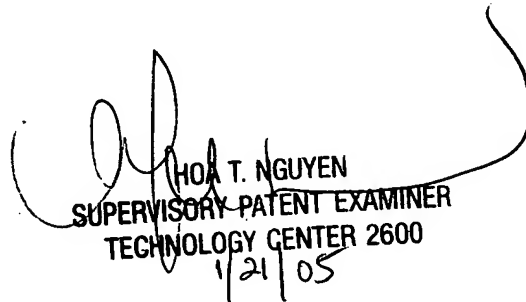
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Vincent Agustin whose telephone number is 703-305-8980. The examiner can normally be reached on Monday-Friday 9:30-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Thi Nguyen can be reached on 703-305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Peter Vincent Agustin  
Art Unit 2652

  
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1/21/05